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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/892,703	06/28/2001	Hiroshi Ohmura	740819-0574	4228
22204	7590	12/05/2005	EXAMINER	
NIXON PEABODY, LLP 401 9TH STREET, NW SUITE 900 WASHINGTON, DC 20004-2128			REFAI, RAMSEY	
			ART UNIT	PAPER NUMBER
			2152	

DATE MAILED: 12/05/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/892,703	Applicant(s) OHMURA ET AL.	
	Examiner Ramsey Refai	Art Unit 2152	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 September 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-6, 8 and 9 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-6, 8, and 9 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Amendment

Responsive to Request for Continued Examination (RCE) filed on September 6, 2005. Claims 1-3 have been amended. Claims 8-9 are new. Claims 1-9 are now pending further examination.

Response to Arguments

1. Applicant's arguments have been considered but are moot in view of the new ground(s) of rejection.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claims 1-3 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for transmitting data to the in-vehicle unit *or* the computer, does not reasonably provide enablement for transmitting data to the in-vehicle unit *and* the computer. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the invention commensurate in scope with these claims. The claims have been amended to describe that the map data is now being transmitted to both an in-vehicle unit *and* a computer. Why and how this is done is not clearly described in the specification. The fact the specification equates the in-vehicle unit and the computer by stating that the data can be sent to an in-vehicle unit *or* a computer and does not clearly describe the

purpose of this feature, its importance to the claimed invention, nor how this is done, conveys to one skilled in that art that this not a vital feature of the applicant's invention and should not have patentable weight.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1-6 and 8-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fujiwara et al (U.S. PGPUB 2004/0012506).

6. As per claim 1, Fujiwara et al teach an information service system comprising:

an in-vehicle unit mounted in a vehicle (**Figure 1**);

a computer installed at a specific; location other than the vehicle (**Figures 1 and 3**); and

a server linked to the in-vehicle unit and the computer via a network (**paragraph [0038]**),

wherein the in-vehicle unit and the computer each comprise map data, the server comprises pieces of map selection data, each of which specifies a map to be selected, and pieces of coordinate data, each of which specifies a point where additional information is to be presented on the, selected map, and is configured to transmit a piece of map selection data and a

piece of coordinate data to the in-vehicle unit or the computer (**Figure 16, paragraphs [002, 006, 008, 009, 0011]**), and

the in-vehicle unit or the computer are configured to present the individual maps by selecting a specified map from among the pieces of map data based on the associated piece of map selection data transmitted from the server and adding information to a specified point on the selected map based on the associated piece of coordinate data transmitted from the server (**Figure 16, paragraphs [002, 006, 008, 009, 0011]**).

7. Fujiwara et al fails to teach that the server transmits the data to the in-vehicle unit *and* the computer. However, it would have been obvious to one of the ordinary skill in the art at the time of the Applicant's invention to transmit data to an in-vehicle unit *and* a computer because doing so would expand the services provided by the server, such navigation services, to users at a personal computers .

8. As per claim 2, Fujiwara et al teach wherein the in-vehicle unit or the computer contains pieces of image data embeddable in an HTML document in addition to the pieces of map data, the server comprises pieces of HTML document data, and pieces of image selection data each of which specifies an image to be embedded in the HTML document and is configured to transmit the map selection data, coordinate data, HTML document data and image selection data to the in-vehicle unit and the computer (**Figure 14, paragraphs [0038, 0112]**), and

the in-vehicle unit or the computer is configured to present the HTML document by selecting a specified image from among the pieces of image data based on the associated piece of image selection data transmitted from the server and adding the selected image to a specified

point on the associated piece of HTML document data transmitted from the server (**Figure 14, paragraphs [0038, 0112]**).

Fujiwara et al fails to teach that the server transmits the data to the in-vehicle unit *and* the computer. However, it would have been obvious to one of the ordinary skill in the art at the time of the Applicant's invention to transmit data to an in-vehicle unit *and* a computer because doing so would expand the services provided by the server, such navigation services, to users at a personal computers

9. As per claims 3, 8, and 9, the claims contain similar limitations as claim 1 above, therefore are rejected under the same rationale.

10. Regarding claims 4-6, the claims recite the in-vehicle unit having limitations corresponding to the above-mentioned. Despite the fact that the claims recites a term "plug-in", the claims do not distinguish over Fujiwara, because the "plug-in" is a known and arbitrarily used in place of modular software, which is required in HTML, JAVA or any other Markup language, to display data on a portable device. Although Fujiwara et al fail to explicitly teach the "plug in" feature, Fujiwara et al's teaching of modular software, including the using of HTML file, meets the scope of the claimed limitations.

Conclusion


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ramsey Refai whose telephone number is (571) 272-3975. The examiner can normally be reached on M-F 8:30 - 5:00 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Bunjob Jaroenchonwanit can be reached on (571) 272-3913. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Ramsey Refai
Examiner
Art Unit 2152

RR 
November 29, 2005


BUNJOB JAROENCHONWANIT
PRIMARY EXAMINER